

Applic. No. 10/534,681
Amdt. dated April 30, 2008
Reply to Office action of February 15, 2008

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APR 30 2008

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 11-24 are now in the application. Claims 18-21 have been amended. Claim 24 has been added. Support for claim 24 can be found on page 9, line 26 to page 10, line 12. No new matter has been added.

In item 2 on page 2 of the above-identified Office action, claims 18-23 have been rejected as being fully anticipated by Frank et al. (U.S. Patent No. 6,705,587 B1) (hereinafter "Frank") under 35 U.S.C. § 102.

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. The claims are patentable for the reasons set forth below. Support for the changes is found in Fig. 2 and on page 9, line 19 to page 10, line 7 of the specification.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Applic. No. 10/534,681
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Claim 18 calls for, *inter alia*:

a coining ring having a contact surface in contact with the step surface, the coining ring having an annular width and a height stamped by a die to an exact predefined distance from the first component, the annular width being wider than the step width for defining an enlarged contact surface for an effective force between the second component and the step, the end surface of second component being in contact with and resting on the enlarged contact surface.

It is once again noted that the corporate assignee of the Frank reference is also the assignee of the instant application. Therefore, applicants are very familiar with the Frank reference.

On page 2 of the Office action the Examiner alleges that Frank discloses "a second component 2 as recited; and a coining ring having an annular width and a height as recited."

It is noted that the Examiner did not designate a particular element of Frank as a coining ring.

Frank discloses a compensation collar (9). As discussed in the previous response the compensation collar does not meet the requirements of the coining ring. However, the compensation collar (9) of Frank is the only element having a surface which contacts the end of the second component (2). Furthermore, the compensation collar (9) of Frank does not

Applic. No. 10/534,681
Amdt. dated April 30, 2008
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have a surface that contacts a surface of the shoulder. As is seen in the figure of the drawing of Frank, Frank discloses another element that rests on the step. Frank does not disclose this other element has a surface, which contacts an end surface of the second component (2). Frank does not disclose that the other element is a coining ring. Therefore, Frank does not disclose a coining ring, as recited in claim 18 of the instant application.

The reference does not show a coining ring having a contact surface in contact with the step surface, the coining ring having an annular width and a height stamped by a die to an exact predefined distance from the first component, the annular width being wider than the step width for defining an enlarged contact surface for an effective force between the second component and the step, the end surface of second component being in contact with and resting on the enlarged contact surface, as recited in claim 18 of the instant application. Frank discloses a coining ring having a surface in contact with an end surface of a second component and another surface in contact with a surface of the shoulder. This is contrary to the invention of the instant application as claimed, which recites a coining ring having a contact surface in contact with the step surface, the coining ring having an annular width and a height stamped by a die to an

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exact predefined distance from the first component, the annular width being wider than the step width for defining an enlarged contact surface for an effective force between the second component and the step, the end surface of second component being in contact with and resting on the enlarged contact surface

Since claim 18 is allowable over Frank, dependent claims 19-24 are allowable over Frank as well.

In item 5 on page 2 of the Office action, claims 11-17 have been rejected as being obvious over Frank (U.S. Patent No. 6,705,587 B1) under 35 U.S.C. § 103.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 11 calls for, *inter alia*:

inserting a die with a first reference mark marked thereon and a longitudinal bore formed therein into the second bore, inserting a probe with a second reference mark into the longitudinal bore until the probe contacts the first component, establishing a reference measurement between the first and second reference marks representing a distance between the lower annular surface of the coining ring and the lower side of the first component, and compressing the coining ring with the die until the reference measurement

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corresponds to a predefined value for the distance.

On page 2 of the Office action the Examiner alleges that "Frank et al. disclose all of the structural limitations of the instant invention. Therefore, whether a product is patentable depends on whether it is known in the art or it is obvious and is not governed by whether the process by which it is made is patentable."

It is respectfully noted that the Examiner's allegation is confusing and not applicable to the method claims of the instant application. Specifically, the Examiner's remarks pertain to a product, however, claim 11 is not a product claim or a product-by-process claim. Instead, claim 11 is strictly a method claim, which recites a method for positioning a component in a housing. The method claim includes many method steps pertaining to coining a coining ring. Therefore, it is respectfully noted that the Examiner's remarks with respect to a product being patentable, are not applicable with respect to the method claim 11 of the instant application.

Frank discloses only surface grinding steps and a prestressing device which is screwed in for deforming the compensation collar (9).

Applic. No. 10/534,681
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It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

As seen from the above-given remarks, the reference does not show or suggest inserting a die with a first reference mark marked thereon and a longitudinal bore formed therein into the second bore, inserting a probe with a second reference mark into the longitudinal bore until the probe contacts the first component, establishing a reference measurement between the first and second reference marks representing a distance between the lower annular surface of the coining ring and the lower side of the first component, and compressing the coining ring with the die until the reference measurement corresponds to a predefined value for the distance, as recited in claim 11 of the instant application.

The references applied by the Examiner do not teach or suggest all the claim limitations. Therefore, it is believed that the Examiner has not produced a *prima facie* case of obviousness.

Since claim 11 is allowable over Frank, dependent claims 12-17 are allowable over Frank as well.

Applic. No. 10/534,681
Amdt. dated April 30, 2008
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It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 11 or 18. Claims 11 and 18 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claims 11 or 18, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 11-23 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

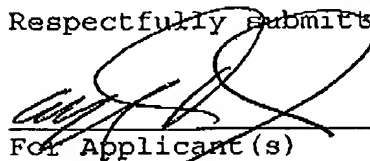
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Please charge any other fees which might be due with respect
to Sections 1.16 and 1.17 to the Deposit Account of Lerner
Greenberg Sterner LLP, No. 12-1099.

Respectfully Submitted,



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